

### **REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application and the courtesy extended during the Examiner Interview on April 28, 2009.

#### **Interview Summary**

An Examiner Interview was conducted on April 28, 2009. During the Interview, the claim language of the pending independent claims and the currently cited prior art was discussed. However, no agreement was reached during the interview.

#### **Examiner Interview**

An Examiner Interview is respectfully requested to discuss the amendments in this response and the prior art. Applicants hereby submit an Applicant Initiated Interview Request Form with this response.

#### **Disposition of the Claims**

Claims 1-15 are pending in this application. Further, claims 16-20 are newly added by way of this reply. Of the amended claims, claims 1 and 8 are independent. The remaining claims depend, directly or indirectly from claims 1 and 8.

**Claim Amendments**

Claims 1, 2, 8, and 15 are amended by way of this reply to clarify the invention. No new subject matter is added by way of this amendment as support may be found, for example, on p. 6 ll. 13-15 and in Figure 2 of the originally filed Specification.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,279,825 (“Yokoyama”) in view of U.S. Pat. No. 7,121,460 (“Parsons”) and in further view of U.S. Pat. No. 6,098,170 (“Devanbu”). To the extent that this rejection applies to the amended claims, this rejection is respectfully traversed.

The claimed invention is directed to a secure terminal. The secure terminal has principal means and peripherals of the principal means. The principal means include processing means, memories for entering stored data and programs, and a keypad for entering data. The peripherals include means of printing, means of reading from/writing to a card, means of access to a telecommunications network, and a power supply unit.

The principal means are combined in a protected box and the peripherals are combined into a non protected box. The non protected box excludes the protected box. In other words, the non protected box containing the peripherals does not contain, within the confines of the box, the protected box that contains the principal means. *See, e.g.*, p. 4, ll. 14 – p. 5, ll. 14 and Figure 2 the originally filed Specification.

Turning to the rejection, MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention

would have been obvious.” The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 75 U.S.L.W. 4289 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. See, MPEP § 2143. The analysis presented by the Examiner to support the rejection of the claims under 35 U.S.C. § 103 in the Action indicates that the Examiner found no differences between the cited prior art and the claims besides a lack of the actual combination of the elements in a single prior art reference, i.e., that the Examiner is relying solely on the teachings of the prior art. See, e.g., MPEP § 2143(A).

Further, when relying on the teachings of the prior art, the subject matter of the claimed invention as a whole must be considered under 35 U.S.C. § 103(a). Considering the subject matter “as a whole” requires that the present application cannot be used as a “road map” for selecting and combining prior art disclosures. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985).

Additionally, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” See MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Turning to the rejection, amended independent claim 1 requires, in part, that a non protected box having the peripherals of the principal means excludes the protected box having the principal means. Amended independent claim 8 includes similar limitations as claim 1. Applicants respectfully assert that Yokoyama, Parsons, and Devanbu, whether considered separately or in combination, fail to disclose or render obvious that a non protected box having the peripherals of the principal means excludes the protected box having the principal means.

Specifically, Yokoyama only discloses a transaction terminal in which the security case is included within the case for the main unit. *See, e.g.*, Yokoyama Figure 2. Yokoyama fails to disclose any other configuration of the security case and the main unit. Because the security case is included within the case for the main unit, Yokoyama cannot disclose or render obvious that a non protected box having the peripherals of the principal means excludes the protected box having the principal means as required by the amended independent claims.

Further Parsons fails to disclose or render obvious that which Yokoyama lacks. As a preliminary matter, Applicant respectfully notes that a peripheral is “an auxiliary device, such as a printer, modem, or storage system, that works in conjunction with a computer.” *See* Peripheral, <http://www.thefreedictionary.com/peripheral>. Retrieved June 2, 2009; *See also* Peripheral, Merriam-Webster, <http://www.merriam-webster.com/dictionary/peripheral>, Retrieved June 2, 2009.

In Parsons, a computer system is in the non-protected component and a cash dispenser is in a secure chest or safe. *See, e.g.*, Parsons, col. 5, ll. 44-54. In other words, applying the well known definition of peripheral discussed above, the peripheral of the computer system in Parsons is the cash dispenser in the secure chest or safe. Because the peripherals are in the secure chest or safe and the computer is in a non secure chest, Parsons fails to disclose or render obvious that a non protected box having the peripherals of the principal means excludes a protected box having the principal means<sup>1</sup>. Rather, Parsons discloses a configuration that is opposite to what is claimed.

---

<sup>1</sup> Claim 1 recites, in part, that principle means include: processing means, memories for storing data and programs, and a keypad for entering data, wherein elements constituting said principal means being interconnected by a first data bus and are combined in a protected box which is impossible to dismantle without deterioration of at least one element of said principal means.

Moreover, because the intent in Parsons is to keep the cash dispenser secure, modifying Parsons to put the cash dispenser (*i.e.*, the peripheral of the computer system in Parsons) in a non protected box would make Parsons unsatisfactory for the intended purpose of Parsons because a nefarious individual would easily be able to steal the cash in the cash dispenser.

Additionally, Devanbu fails to disclose or render obvious that which Yokoyama and Parsons lack. Specifically, Devanbu is directed to providing backup using redundant storage resources. When the memory of one storage resource is full, data is transferred to a second resource. *See, e.g.*, Devanbu col. 1, ll. 34-42. Devanbu is completely silent with regards to a non protected box having the peripherals of the principal means excluding a protected box having the principal means as required by amended independent claims 1 and 8.

As shown above, Yokoyama, Parsons, and Devanbu, whether considered together or separately, fail to disclose or render obvious all of the limitations of claims 1 and 8. Accordingly, claims 1 and 8 are patentable over Yokoyama, Parsons, and Devanbu. Dependent claims 2-7 and 9-15 are patentable over Yokoyama, Parsons, and Devanbu for at least the same reasons. Withdrawal of this rejection is respectfully requested.

**New Claims**

Dependent claims 16-20 are newly added by way of this reply. No new subject matter is added by way of the new claims as support for the new claims may be found, for example, on p. 6 ll. 7-21 and in Figure 2 of the originally filed Specification. Dependent claims 16-20 depend, directly or indirectly, from claims 1 and 8 and are patentable over the cited art for at least the same reasons as claims 1 and 8.

Further, dependent claims 16-20 recite additional limitations regarding the configuration of the protected box and the non-protected box having the peripherals. Because Yokoyama, Parsons, and Devanbu, whether considered together or separately, fail to disclose or render obvious that a non protected box having the peripherals of the principal means excludes a protected box having the principal means, Yokoyama, Parsons, and Devanbu cannot disclose or render obvious the specific configurations between the protected box and the non-protected box required by dependent claims 16-20.

For the reasons set forth above, dependent claims are additionally patentable over Yokoyama, Parsons, and Devanbu. Favorable consideration of dependent claims 16-20 is respectfully requested.

**Conclusion**

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed

below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/091001).

Dated: June 3, 2009

Respectfully submitted,

By /Jonathan P. Osha/  
Jonathan P. Osha  
Registration No.: 33,986  
OSHA · LIANG LLP  
909 Fannin Street, Suite 3500  
Houston, Texas 77010  
(713) 228-8600  
(713) 228-8778 (Fax)  
Attorney for Applicants

Attachment (Applicant Initiated Interview Request Form)